

REMARKS

Applicants respectfully request entry of the following amendments and remarks in response to the Office Action mailed April 25, 2008. Applicants respectfully submit that the amendments and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 1 – 20 and 22 are pending. In particular, Applicants add claim 22, amend claims 1, 9 – 10, and 14, and cancel claim 21. Applicants cancel claim 21 merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Examiner Interview

Applicants first wish to express sincere appreciation for the time that Examiner Chang spent with Applicants' Attorney, Anthony Bonner, during a telephone discussion on June 28, 2008 regarding the outstanding Office Action. During that conversation, Examiner Chang and Mr. Bonner discussed potential arguments and amendments with regard to claim 1, in view of *Bernstein*. The general thrust of the potential principal arguments included a discussion of at least one embodiment of the present application disclosing performing one or more action at an instant messaging client. Thus, Applicants respectfully request that Examiner Chang carefully consider this response and the amendments.

II. Rejections Under 35 U.S.C. §102

A. Claim 1 is Allowable Over *Bernstein*

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Publication Number 2004/0128356 ("*Bernstein*"). Applicants respectfully traverse this rejection on the grounds that *Bernstein* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 1 recites:

A method comprising:
determining, by an instant messaging client, an Internet
presence of a contact identified in an email message; and
initiating, ***by the instant messaging client***, an instant
messaging (IM) chat session with the contact in response to
determining that the contact is present.
(Emphasis added).

Applicants respectfully submit that *Bernstein* fails to disclose, teach, or suggest a "method comprising... initiating, ***by the instant messaging client***, an instant messaging (IM) chat session with the contact in response to determining that the contact is present" as recited in claim 1, as amended. More specifically, *Bernstein* discloses an "initial chat request is not delivered via an Instant Message, rather it is delivered in an email. Upon receipt of the email invitation, the recipient initiates an Instant Messaging conversation with the sender" (page 2, paragraph [0016]). As illustrated in this passage, it appears that *Bernstein* discloses that a user views an instant messaging interface, which provides information regarding whether a contact is present and, in response to receiving this information, the user initiates the instant messaging conversation. As this is completely different than "initiating, ***by the instant messaging client***, an instant messaging (IM) chat session with the contact in response to determining that the contact is present" claim 1, as amended, is allowable.

B. Claim 9 is Allowable Over *Bernstein*

The Office Action indicates that claim 9 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Publication Number 2004/0128356 ("*Bernstein*"). Applicants respectfully traverse this rejection on the grounds that *Bernstein* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 9 recites:

A system comprising:
means for, at an instant messaging client, determining an Internet presence of a contact identified in an email message; and
means for, ***at an instant messaging client***, initiating an instant messaging (IM) chat session with the contact in response to determining that the contact is present.

(Emphasis added).

Applicants respectfully submit that *Bernstein* fails to disclose, teach, or suggest a “system comprising... means for, ***at an instant messaging client***, initiating an instant messaging (IM) chat session with the contact in response to determining that the contact is present” as recited in claim 9, as amended. More specifically, *Bernstein* discloses an “initial chat request is not delivered via an Instant Message, rather it is delivered in an email. Upon receipt of the email invitation, the recipient initiates an Instant Messaging conversation with the sender” (page 2, paragraph [0016]). As illustrated in this passage, it appears that *Bernstein* discloses that a user views an instant messaging interface, which provides information regarding whether a contact is present and, in response to receiving this information, the user initiates the instant messaging conversation. As this is completely different than “means for, ***at an instant messaging client***, initiating an instant messaging (IM) chat session with the contact in response to determining that the contact is present” claim 9, as amended, is allowable.

C. Claim 10 is Allowable Over *Bernstein*

The Office Action indicates that claim 10 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Publication Number 2004/0128356 (“*Bernstein*”). Applicants respectfully traverse this rejection on the grounds that *Bernstein* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 10 recites:

A system comprising:
presence logic, at an instant messaging client, configured to determine an Internet presence of a contact identified in an email message; and
chat-initiation logic, ***at an instant messaging client***, configured to initiate an instant messaging (IM) chat session with the contact in response to determine that the contact is present.

(Emphasis added).

Applicants respectfully submit that *Bernstein* fails to disclose, teach, or suggest a “system comprising... chat-initiation logic, ***at an instant messaging client***, configured to initiate an instant messaging (IM) chat session with the contact in response to determine that the contact is present” as recited in claim 10, as amended. More specifically, *Bernstein* discloses an “initial chat request is not delivered via an Instant Message, rather it is delivered in an email. Upon receipt of the email invitation, the recipient initiates an Instant Messaging conversation with the sender” (page 2, paragraph [0016]). As illustrated in this passage, it appears that *Bernstein* discloses that a user views an instant messaging interface, which provides information regarding whether a contact is present and, in response to receiving this information, the user initiates the instant messaging conversation. As this is completely different than “chat-initiation logic, ***at an instant messaging client***, configured to initiate an instant messaging (IM) chat session with the contact in response to determine that the contact is present” claim 10, as amended, is allowable.

D. Claim 14 is Allowable Over *Bernstein*

The Office Action indicates that claim 14 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Publication Number 2004/0128356 (“*Bernstein*”). Applicants respectfully traverse this rejection on the grounds that *Bernstein* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 14 recites:

A computer-readable storage medium comprising:
computer-readable code adapted to instruct a programmable device to determine, at an instant messaging client, an Internet presence of a contact from an email message;
and

computer-readable code adapted to instruct a programmable device to initiate, ***at an instant messaging client***, an instant messaging (IM) chat session with the contact in response to determining that the contact is present.

(Emphasis added).

Applicants respectfully submit that *Bernstein* fails to disclose, teach, or suggest a “computer-readable storage medium comprising... computer-readable code adapted to instruct a programmable device to initiate, ***at an instant messaging client***, an instant messaging (IM) chat session with the contact in response to determining that the contact is present” as recited in claim 14, as amended. More specifically, *Bernstein* discloses an “initial chat request is not delivered via an Instant Message, rather it is delivered in an email. Upon receipt of the email invitation, the recipient initiates an Instant Messaging conversation with the sender” (page 2, paragraph [0016]). As illustrated in this passage, it appears that *Bernstein* discloses that a user views an instant messaging interface, which provides information regarding whether a contact is present and, in response to receiving this information, the user initiates the instant messaging conversation. As this is completely different than “computer-readable code adapted to instruct a programmable device to initiate, ***at an instant messaging client***, an instant messaging (IM) chat session with the contact in response to determining that the contact is present” claim 14, as amended, is allowable.

E. Claims 2 – 8, 11 – 13, and 15 – 21 are Allowable Over *Bernstein*

The Office Action indicates that claims 2 – 8, 11 – 13, and 15 – 21 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Publication Number 2004/0128356 (“*Bernstein*”). Applicants respectfully traverse this rejection on the grounds that *Bernstein* does not disclose, teach, or suggest all of the claimed elements. More specifically, dependent claims 2 – 8 are believed to be allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 1. Dependent claims 11 – 13 are believed to be allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 10. Dependent claims 15 – 21 are believed to be allowable for at least the reason that these claims depend from and include the elements of allowable

independent claim 14. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, all objections and/or rejections have been traversed, rendered moot, and/or addressed, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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